

REMARKS

Status of the Claims

Claims 5-14 are pending.

Issues Under 35 U.S.C. § 103

The Basis of the Rejection

Claims 5-14 are rejected under 35 U.S.C. § 103 as allegedly being obvious over US '914 in view of Sitrick et al. (US 2003/0110926). This rejection is respectfully traversed.

Reconsideration and withdrawal thereof are requested.

These two references are discussed exhaustively in the record. Applicant continues to maintain that the rejection is improper, that the rejection does not even approach the standards for establishing a *prima facie* case of obviousness as set forth by the Federal Circuit, and that the rejection represents a classic case of improperly “picking and choosing.” Additionally, the Examiner is using hindsight to piece together a stringed instrument that comprises the computer unit as claimed.

For the guitar portion of the combination, the Examiner has picked material from '914 patent. It is a training guitar. The “computer or microprocessor” referenced in the office action coordinates “an array of LEDs and LDCs that indicate the strings to finger, the fingers to use, the strings to play and the direction to play.” See col. 2 of '914. Beyond the “freeze” control, or selecting the training CD to play, there is no to little user input. This training guitar is essentially a fingering display.

The secondary reference is a complicated system that comprises multiple workstations that share a music database. The system comprises many components that include, for example, a performer subsystem, a processing system, librarian logic, performance logic, communications management logic.

The Office Action appears to be based on the notion that one of ordinary skill in the art would be motivated to take an extremely small element of the system of Sitrick, remove it from the system, and use it to replace or modify the microprocessor in the training guitar.

The Proper Obviousness Analysis

Graham Factors

The Supreme Court set forth the standard for conducting an obviousness analysis in Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966). In Graham, the Court held that the obviousness analysis begins with several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issues are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved. 383 U.S. at 17. Only following these determination can the objective determination of obviousness can occur.

Analogous Art Test

Another test, the “analogous art” test, has long been part of the primary Graham analysis articulated by the Supreme Court. This test requires that the USPTO show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In *re* Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). “[I]t is necessary to consider ‘the reality of the circumstances,’ - in other words, common sense - in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *In re* Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979). It has been explained that if a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re* Clay, 966 F.2d 656, 659-60 (Fed. Cir. 1992).

Motivation-Suggestion-Teaching

The Supreme Court, as well as the Federal Circuit and its predecessor have long established many safeguards to prevent hindsight when determining obviousness, including in the establishment of the “motivation to combine requirement.” See, for example, *In re* Fridolph, 30 CCPA 939, 942 (1943) (“[I]n considering more than one reference, the question always is:

does such art suggest doing the thing the [inventor] did.”). As the Federal Circuit explained in In re Kahn, 441 F. 3d 977, 987 (Fed. Cir. 2006):

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law...

Importantly, the Federal Circuit has further explained that “[a]t its core, our jurisprudence is a test that rests on the unremarkable premise that legal determination of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation on conjecture.” See Alza Corporation v. Mylan Laboratories, 464 F.3d 1286 (Fed. Cir. 2006).

Most inventions arise from a combination of old elements and each element may often be found in the prior art. See In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the USPTO must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the USPTO “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357-59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the Graham

test. When the USPTO does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, the Federal Circuit infers that the Board used hindsight to conclude that the invention was obvious. Id. at 1358.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002). This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in § 103. Id. at 1344-45.

The Present Rejection

Applicant respectfully submits that the present rejection fails to consider the basic factual inquiries set forth in Graham, relies upon non-analogous art in making the rejection, and fails to provide any rational to explain the rational for the alleged motivation to combine the references in the manner suggested.

For example, with respect to the Graham factors, there appears to be no analysis of the scope and content of the prior art. To characterize the Sitrick reference solely in terms of “an operating system” is too simplistic and misleading.

One of ordinary skill in the art would not look at the reference as a whole and state “That reference is an operating system.” As Applicant has previously stated, the secondary reference is a complex system that comprises multiple workstations that share a music database. The system

comprises many components that include, for example, a performer subsystem, a processing system, librarian logic, performance logic, communications management logic. The disclosed music stands, for example, can be electronically connected to allow multiple users to see, share, and record music.

Applicant respectfully submits that there is nothing in Sitrick that is incorporated into a musical instrument. Music stands joined by a complicated system are not stringed instruments.

Additionally, with respect to Graham, the differences between the cited prior art and the claims are numerous. With respect to the primary reference, the claims are directed to a stringed musical instrument that, of course, can be a guitar. The training guitar of the reference is significantly different in that the many LEDs and training devices would not allow this guitar to be an attractive option for a performer. Additionally, based on the training nature of this guitar, there would not be as a significant need for the operating system as claimed.

The differences between the secondary reference and the present invention are so great that the secondary reference should be considered non-analogous to one of ordinary skill in the art.

The Sitrick reference is used to read and record music in a multiple workstation format. There is no indication that any part of it can be used to play music. Applicant respectfully submits that the secondary reference is a series of music stands that are linked together. What the reference describes as “stand alone” still fits within the described system. The fact that they are both tangentially related to music – creating (the claims) vs. displaying (applied prior art) does not rise to the level of being analogous. There is nothing in the system that would be considered

a musical instrument, other than the simple fact that one can be plugged into the system for recording. There is nothing in the system that is incorporated into a musical instrument. A music stand is not analogous to a musical instrument in terms of relevant prior art. The “field of endeavor,” commonly referred to by courts, of the prior art is displaying and recording music in a system for multiple users.

Finally, the Office Action grossly fails to adequately describe why one of ordinary skill in the art would pick and choose from the references to make the modification as suggested. The Examiner is requested to carefully review the paragraphs cited in the office action, and explain why it would be obvious to pull these portions out of the Sitrick system and, somehow from there, arrive at the present invention. For example, sections relied upon by the Examiner include a touch screen feature on the touch screen on the workstation stand. Additionally, paragraph 52, for example, describes an input device to couple a musical instrument to the entire stand system of the reference, to allow an instrument such as a keyboard to be directly input into the workstation.

There is no indication that the “operating system” can be removed from the music stand multiple workstation system and incorporated into an instrument as claimed. The hand held embodiment ([0065]) cited by the examiner still operates within the total system. This embodiment is described as being suitable for a performer, student, or stage hand. Applicant does not understand, based on the office action, or based on reason, why this feature would motivate one to modify an instrument to incorporate an independent computer unit, for example. There is simply nothing in the reference that suggest what the office action does.

There is no indication that one element, a music stand-type display, for example, can be separated from the system and used individually. There is no indication that it would make sense or further the workability to separate the various parts and incorporate them into different, independent objects. There is no indication that, once separated from the Sitrick system, an individual component can be incorporated into a music instrument independent from the overall system. Additionally, just looking at the reference, why would one want to do that anyway? As previously stated, the system of Sitrick does not approach the portability of the computer unit in combination with the stringed instrument as claimed.

Does the reference suggest substituting a music stand for an instrument, then removing that instrument from the system of the reference, for independence and portability, for example? The art must suggest the desirability.

When the two disclosures are viewed as a whole, (i) the CD-based training guitar, with LED frets and strings of the primary reference, and (ii) the multiple workstation music stand communications system of the secondary reference, there is no showing that one of ordinary skill in the art, when confronted with same problem of the inventor, and with no knowledge of the present invention, would have selected the various elements, and portions of elements from the prior art in the claimed manner.

Applicants respectfully submit that the format of the present office action, (i) describe the primary reference, (ii) pick a feature of an unrelated secondary reference to combine with the primary reference, and (iii) summarily state that “[t]herefore it would have been obvious... to use the standard computer and imaging techniques presented by Sitrick et al. in the computer unit positioned in the body of the stringed instrument shown by Breitweiser et al.” No reason is given

why a microprocessor that operates LED lights should or could be replaced with an operating system as complicated as the one in Sitrick. Is there a basis for the assumption that a training guitar to become a shared music database workstation?

The Federal Circuit has stated that when the basis on which it is concluded all the elements can be modified and combined is not specifically articulated, hindsight is improperly used to conclude the invention was obvious. See In re Kahn, 78 U.S.P.Q.2d 1329,1355 (Fed. Cir. 2006). The “basis” is lacking from the rejection.

This “basis,” or the “why,” or explanation that Applicants continue to ask for is not optional, as stated above. Reliance on generalities is not an option. Specificity and objectivity are required. The Federal Circuit requires a “rigorous application of the requirements of the requirement for a showing of the teaching or motivation to combine the prior art references. See *In re Deabiczack*, 175 F3d. 994 (Fed. Cir. 1999) (the famous jack-o-lantern garbage bag case), where the court indicated that the hindsight reconstruction is particularly tempting with an invention involving simple technology.

In view of the above described deficiencies in the references, and the failure to establish a *prima facie* case of obviousness Applicant respectfully submits that the pending claims cannot be said to be obvious over the previously cited references.

From the foregoing, further and favorable reconsideration in the form of a Notice of Allowance is believed to be in order and such action is earnestly solicited.

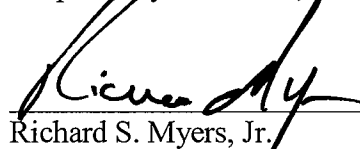
Petition for Extension of Time

Pursuant to 37 C.F.R. § 1.17 and 1.136(a) Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$510.00 is filed herewith.

The Commissioner is authorized to charge any deficiency or credit any overpayment associated with this Amendment to Deposit Account 50-2752.

If the Examiner has any questions regarding this Amendment or the Application in general, she is requested to contact the undersigned at the number listed below.

Respectfully submitted,



Richard S. Myers, Jr.
Registration No. 42,022
STITES & HARBISON, PLLC
424 Church Street, Suite 1800
SunTrust Center
Nashville, TN 37219
(615) 244-5200

Attorney for Applicant